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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/733,742	12/11/2003	Conleth O'Connell	VIGN1640-2	8405
44654	7590	06/06/2006	EXAMINER	
SPRINKLE IP LAW GROUP 1301 W. 25TH STREET SUITE 408 AUSTIN, TX 78705			PATEL, HETUL B	
			ART UNIT	PAPER NUMBER
			2186	

DATE MAILED: 06/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/733,742

Applicant(s)

O'CONNELL ET AL.

Examiner

Hetul Patel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 02/13/2006.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to communication filed on April 12, 2006. This amendment has been entered and carefully considered. Claims 44-45 are newly added, therefore, claims 1-45 are pending in this application.
2. The IDS filed on 02/13/2006 has been received and carefully considered.
3. Applicant's arguments filed on April 12, 2006 have been fully considered but are moot in view of new ground(s) of rejection.

Double Patenting

4. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

5. Claims 44 and 45 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 36 and 37 of copending Application No. 10/733,798.

This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

6. Claims 44 and 45 of this application conflict with claims 36 and 37 of Application No. 10/733,798. 37 CFR 1.78(b) provides that when two or more applications filed by

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the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1-45 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

As per independent claims 1, 15, 29 and 44, it is not clear where Applicant has support for the limitation of “regenerating a request from metadata associated with content previously stored in the cache, wherein the previously stored content was generated based on the request” in the specification and figures.

All dependent claims are rejected as having the same deficiencies as the claims they depend upon.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1, 15 and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Rosenberg et al. (USPN: 5,740,430) hereinafter, Rosenberg.

As per claim 1, Rosenberg teaches a method for updating a cache comprising regenerating a request (i.e. the request for a file) from metadata (i.e. the set of information which sent to the client computer; see Col. 5, lines 30-35) associated with content (i.e. the customized page corresponding to the requested file name) previously stored in the cache, wherein the previously stored content (i.e. the standard files) was generated based on the request; receiving new content (i.e. the updated HTML file), wherein the new content (i.e. the customized page corresponding to the requested file name) is generated based on the request; and replacing the previously stored content with the new content in the cache (e.g. see Col. 5, lines 30-35 and the abstract).

As per claims 15 and 29, see arguments with respect to the rejection of claim 1. Claims 15 and 29 are also rejected based on the same rationale as the rejection of claim 1.

9. Claims 1-7, 10-12, 16-20, 23-25, 29-35 and 38-40 are rejected under 35 U.S.C. 102(b) as being anticipated by Shen (USPN: 5,946,697).

As per claim 1, Shen teaches a method for updating a cache comprising regenerating a request (i.e. the checksum or macro name file for each construct in the cached HTML file) from metadata (i.e. the macro definition file) associated with content (i.e. the cached HTML file) previously stored in the cache, wherein the previously stored content was generated based on the request (i.e. when checking whether the HTML document cached on the client computer is updated on the server computer, the request remains same, i.e. the same macro name file is used to check for updated data on the server computer); receiving new content (i.e. the updated HTML file), wherein the new content is generated based on the request; and replacing the previously stored content with the new content in the cache (e.g. see the abstract).

As per claim 2, Shen teaches the claimed invention as described above and furthermore, Shen teaches that the method further comprising receiving information (i.e. the user request to access the HTML document on the server computer) on updated content (i.e. the updated HTML file) (e.g. see the abstract).

As per claim 3, Shen teaches the claimed invention as described above and furthermore, Shen teaches that the request (i.e. the checksum or macro name file) is

generated in response to the information (i.e. the user request to access the HTML document on the server computer) received (e.g. see the abstract).

As per claim 4, Shen teaches the claimed invention as described above and furthermore, Shen teaches that the metadata is request metadata (i.e. the macro definition file) and the information received pertains to the request metadata (e.g. see the abstract).

As per claim 5, Shen teaches the claimed invention as described above and furthermore, Shen teaches that the information is received by a cache manager (i.e. the client agent software module) (e.g. see the abstract).

As per claim 6, Shen teaches the claimed invention as described above and furthermore, Shen teaches that the request is regenerated by the cache manager (i.e. the client agent software module) (e.g. see the abstract).

As per claim 7, Shen teaches the claimed invention as described above and furthermore, Shen teaches that the method further comprising sending the information, wherein the information is sent by an application manager (i.e. the user).

As per claim 10, Shen teaches the claimed invention as described above and furthermore, Shen teaches that the method further comprising locating the previously stored content in the cache (i.e. locating the cached HTML file) (e.g. see the abstract).

As per claim 11, Shen teaches the claimed invention as described above and furthermore, Shen teaches that the locating previously stored content comprises comparing the received information with the template metadata (i.e. the macro definition

file) associated with the previously stored content (i.e. the cached HTML file) (e.g. see the abstract).

As per claim 12, Shen teaches the claimed invention as described above and furthermore, Shen teaches that the locating previously stored content comprises comparing the received information with the request metadata (i.e. the macro definition file) associated with the previously stored content (i.e. the cached HTML file) (e.g. see the abstract).

As per claims 16-19, see arguments with respect to the rejection of claims 1-4, respectively. Claims 16-19 are also rejected based on the same rationale as the rejection of claims 1-4, respectively.

As per claims 29-35, see arguments with respect to the rejection of claims 1-7, respectively. Claims 29-35 are also rejected based on the same rationale as the rejection of claims 1-7, respectively.

As per claims 20 and 23-25, see arguments with respect to the rejection of claims 7 and 10-12, respectively. Claims 20 and 23-25 are also rejected based on the same rationale as the rejection of claims 7 and 10-12, respectively.

As per claims 38-40, see arguments with respect to the rejection of claims 10-12, respectively. Claims 38-40 are also rejected based on the same rationale as the rejection of claims 10-12, respectively.

10. Claims 44-45 are rejected under 35 U.S.C. 102(e) as being anticipated by O'Connell, Jr. et al. (USPN: 7,024,452) hereinafter, O'Connell.

The applied reference has a common assignee and inventor(s) with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

As per claim 44, O'Connell teaches a method for caching, comprising:

- generating and storing first content (i.e. the caching content component) responsive to a request (i.e. step 402 in Fig. 4) in a cache (i.e. step 626 in Fig. 6);
- associating first metadata (i.e. the mapped filename) with the first content, wherein the first metadata is determined by evaluating a parameter of the request (i.e. by parsing the request; steps 422 and 424 in Fig. 4);
- regenerating the request based on the first metadata associated with the first content (i.e. checking whether the requested data is in the cache; step 426 in Fig. 4);
- obtaining second content responsive to the request (i.e. step 502 in Fig. 5);
and
- replacing the first content with the second content in the cache (i.e. step 562 in Fig. 5) (e.g. see Figs. 4-6 and Col. 6, lines 59+).

As per claim 45, O'Connell teaches the claimed invention as described above and furthermore, O'Connell teaches that the method further comprising:

- receiving second metadata (i.e. receiving the second/next request for a different file; step 402 in Fig. 4); and
- comparing the second metadata to the first metadata to identify the first content (i.e. step 562 in Fig. 5) (e.g. see Figs. 4-6 and Col. 6, lines 59+)..

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 8-9, 21-22 and 36-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shen in view of Li et al. (USPN: 6,591,266) hereinafter, Li.

As per claim 8, Shen teaches the claimed invention as described above, but failed to teach that the information is sent in response to a content change, metadata change, or template change. Li, however, teaches that the information (i.e. the identity of modified data) is sent in response to a content change (i.e. the modification in the data stored in web pages) (e.g. see the claim 1). Accordingly, it would have been obvious to one ordinary skilled in the art at the time of the current invention was made to implement the teaching of Li in the method taught by Shen. In doing so, the web pages stored in the cache can be updated based on the information sent in response to the

modification on the web pages on the server. Therefore, the web page at the client/end-user screen is automatically updated whenever the web page on the server updated.

As per claim 9, the combination of Shen and Li teaches the claimed invention as described above and furthermore, Shen teaches that the information is sent via HTTP (i.e. using HTML document) (e.g. see the abstract).

As per claims 21 and 22, see arguments with respect to the rejection of claims 8-9, respectively. Claims 21 and 22 are also rejected based on the same rationale as the rejection of claims 8-9, respectively.

As per claims 36 and 37, see arguments with respect to the rejection of claims 8-9, respectively. Claims 36 and 37 are also rejected based on the same rationale as the rejection of claims 8-9, respectively.

12. Claims 13-15, 26-28 and 41-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shen in view of Chow et al. (USPN: 6,029,175) hereinafter, Chow.

As per claims 13 and 14, Shen teaches the claimed invention as described above. However, Shen failed to teach the regenerating request is not based on a user request. Chow, on the other hand, teaches that the regenerating the request (i.e. checking for the updated data on the server) is based on a timer not based on a user request (e.g. see Col. 3, lines 19-25). Accordingly, it would have been obvious to one ordinary skilled in the art at the time of the current invention was made to implement Chow's timer in the method taught by Shen. In doing so, the retrieval of the

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changed/updated content from the server can be done automatically instead of manually requesting for it and waiting for the updated data to be retrieved.

As per claim 15, the combination of Shen and Chow teaches the claimed invention as described above and furthermore, Chow teaches that the timer is associated with the previously stored data, i.e. the previously stored data is refreshed based on the timer (e.g. see Col. 3, lines 19-25).

As per claims 26-28, see arguments with respect to the rejection of claims 13-15, respectively. Claims 26-28 are also rejected based on the same rationale as the rejection of claims 13-15, respectively.

As per claims 41-43, see arguments with respect to the rejection of claims 13-15, respectively. Claims 41-43 are also rejected based on the same rationale as the rejection of claims 13-15, respectively.

Remarks

13. As to the remark, Applicant asserted that

- (a) Applicant respectfully submits that the metadata associated with previously stored content of Claim 1 is not equivalent to a set of HTML constructs or lists (i.e. the macro definition file) of Shen.

(b) If a macro name file is equated with the request of Claim 1 as asserted by the Examiner, it would mean that the cached HTML content of Shen (previously stored content) was generated through the use of a file which comprises macro names formed from the cached HTML document (i.e. the previously stored content was generated based on a file formed from previously stored content). Applicant respectfully submits that this is paradoxical and contradictory. Thus, Applicant respectfully submits that the request of claim 1 is not equivalent to the macro name file of Shen and that Shen does not disclose regenerating a request from metadata associated with content previously stored in the cache wherein the previously stored content was generated based on the request, as recited by Claim 1.

Examiner respectfully traverses Applicant's remark for the following reasons:

With respect to (a) and (b), Examiner would like to point out to Applicant that in the method taught by Shen when a user requests access to the HTML document on a server computer corresponding to the cached HTML document on the client computer, the same macro filename(s) are used to check for updated data on the server computer. For example, first time when a user is requesting HTML content from the server, the requested HTML content get stored in the cache of the client computer with specific file name(s) (e.g. "XYZ"). When user trying to access/request the same content again, the client computer will use the same file name (i.e. "XYZ") to make sure any data

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corresponding to that file is updated on the server and if it is updated on the server, the updated file get retrieved on the client computer cache.

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hetul Patel whose telephone number is 571-272-4184. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matt Kim can be reached on 571-272-4182. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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